

REMARKS

Claims 1-38 are pending in this application. Applicants respectfully traverse the ten way restriction requirement imposed by the Examiner on July 31, 2003 for the reasons that follow.

For a restriction requirement, the MPEP requires that the Examiner show that there is a patentable distinction between the designated groups of claims by providing appropriate explanation as to 1) separate classification, 2) separate status in the art, or 3) different field of search for each related invention for each group of claims. MPEP § 808.02(A)-(C). Thus, the Examiner is required to explain why each group is distinct from every other group, not just from one of the groups.

In this case, however, the Examiner has failed to show any of these requirements. Instead, the Examiner has only provided his reasons for insisting upon restriction between Group I and the remaining nine groups, but not between each group set forth in the restriction. As such, there is no support in the restriction as to why the remaining nine groups are either independent or distinct from each other as required by the MPEP. For example, the Examiner identified his reasons for restriction of Group IV from Group I, but did not explain his reasons for restriction of Group IV from Group V, despite the fact the Groups IV and V appear to be identically described by the Examiner. Likewise, the Examiner identified his reasons for restricting Group III from Group I, but did not provide his reasons for restricting Group III from Group VII, even though these groups are also described identically by the Examiner.

Furthermore, the Examiner has restricted groups of claims that the Examiner acknowledge as having the same classification and directed to the same product: a golf ball. For example, Groups III, VI, VII, and IX are classified in class 473 (games using a tangible projectile). The Examiner also provided the same subclass for these groups where one was provided. Likewise, Groups II, VIII, and X are classified in class 525 (directed to synthetic resins or natural rubbers). The Examiner has also classified both Groups IV and V as class 264 (plastic and nonmetallic article shaping or treating: *processes*) even though these claims are directed to a golf ball product. In addition to the lack of evidence of separate classification for these groups, there is also no evidence of separate status in the art or different field of search.

Moreover, all of the groups of claims described as being in classes 473 and 525 are directed to games using a tangible projectile involving synthetic resins or natural rubbers.

Therefore, an appropriate search of these claims would involve a search of both classes and likely subclass 351 (subject matter wherein the playing equipment comprises a spherical object struck by the player in playing the game competitively). As such, Applicants respectfully submit that examination of all of the pending claims would not place any additional burden on the Examiner during prosecution.

Assuming that, *arguendo*, any restriction in this case were proper, Applicants respectfully submit that, at best, the claims should be restricted between the product claims and process under MPEP § 806.05(f). If a restriction were made along these lines, Group I would include claims 1-23 and 37, possibly classified in class 473, subclass 351 and class 525, and Group II would include claims 24-36 and 38, possibly classified in class 264. If presented with such a restriction, Applicants would elect claims 1-23 and 37.

For the reasons above, Applicants respectfully request withdrawal of the restriction requirement and examination on the merits of all the claims. In the event that the Examiner decides to maintain the current Restriction Requirement, however, Applicants hereby elect, with traverse, the invention of Group IV (claims 10-13) for prosecution in this application.

CONCLUSION

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Swidler Berlin Shereff Friedman, LLP Deposit Account No. 195127, Order No. 20002.0041.

Respectfully submitted,

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